



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/559,950

11/08/2006

Roger William Frank Ashton

10557/323978

1482

30559

7590

11/09/2010

DIANA HOUSTON  
SMITH & NEPHEW, INC.  
1450 BROOKS ROAD  
MEMPHIS, TN 38116

EXAMINER

WOLF, MEGAN YARNALL

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

11/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/559,950	<b>Applicant(s)</b> ASHTON ET AL.	
	<b>Examiner</b> Megan Wolf	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-14,16-25 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,14,20-25 and 32-37 is/are rejected.
- 7) ☒ Claim(s) 4-13 and 16-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>030110, 052810</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3/1/10 has been entered.

### ***Response to Amendment***

2. Upon review of the documents submitted in the Information Disclosure Statement of 3/1/10, specifically the office action dated 8/7/08 in corresponding European Patent Application No. 04736652.1, the previously allowed claims are now rejected as discussed below.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3738

4. Claims 1, 3, 20, 21, 23, 25, and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by White et al. 6,416,553 (hereafter referred to as White). White discloses a kit of parts for a fixing assembly for securing a fixing member to an acetabular cup, the fixing assembly comprising the prosthetic component 242 having a female location feature 244, a fixing member 252 having a male location feature (the outer surface of 252), the male and female location features fitting together in use (fig.13a) and a screw 250 that passes through an aperture 258 extending through the fixing member to secure the fixing member to the prosthetic component, the screw oriented in the aperture of the fixing member to secure purchase of the screw to a bone in which the prosthetic component is implanted, wherein threaded disposition of the screw in the fixing member causes securing of the fixing member to the prosthetic component to occur whether or not the screw gains purchase in the bone (col.10, ll.14-31), and wherein the fixing member is configured to connect rotatably to the prosthetic component (col.10, ll.32-41).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 14, 20-25, and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietschi 4,919,675 (hereafter referred to as Dietschi) in view of White. Dietschi discloses a fixing assembly comprising a prosthetic component 3 having

Art Unit: 3738

a female location feature 7 for accepting a fixing member and screw wherein the location feature 7 is partially located on a rim 6 of the prosthetic component and secured to an external surface 6 of the prosthetic component (col.2, ll.62-67; figs. 1, 2).

While Dietschi discloses the invention substantially as claimed, Dietschi does not disclose a fixing member having a male location feature the male and female location features fitting together in use and a screw that passes through an aperture extending through the fixing member to secure the fixing member to the prosthetic component, the screw oriented in the aperture of the fixing member to secure purchase of the screw to a bone in which the prosthetic component is implanted, wherein threaded disposition of the screw in the fixing member causes securing of the fixing member to the prosthetic component to occur whether or not the screw gains purchase in the bone, and wherein the fixing member is configured to connect rotatably to the prosthetic component.

White teaches a fixing assembly, in the same field of endeavor, wherein a prosthetic component 242 has a female location feature 244, a fixing member 252 having a male location feature (the outer surface of 252), the male and female location features fitting together in use (fig.13a) and a screw 250 that passes through an aperture 258 extending through the fixing member to secure the fixing member to the prosthetic component, the screw oriented in the aperture of the fixing member to secure purchase of the screw to a bone in which the prosthetic component is implanted, wherein threaded disposition of the screw in the fixing member causes securing of the fixing member to the prosthetic component to occur whether or not the screw gains purchase in the bone (col.10, ll.14-31), and wherein the fixing member is configured to

Art Unit: 3738

connect rotatably to the prosthetic component (col.10, ll.32-41), for the purpose of allowing for adjustability of the screw (col.10, ll.32-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the fixing assembly of Dietschi to include the female location feature, fixing member, and screw of White in order to allow the surgeon to adjust the angle of the screw to accommodate an individual patient's unique bone structure.

### ***Allowable Subject Matter***

7. Claims 4-13 and 16-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Megan Wolf whose telephone number is (571)270-3071. The examiner can normally be reached on Monday-Friday 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. W./  
Examiner, Art Unit 3738

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738